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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,589	10/13/2001	Tsung-Mou Yu	UPA-01208	2757

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EXAMINER
VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
2835	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	**Application No.**	**Applicant(s)**	
	09/977,589	YU, TSUNG-MOU	
	Examiner	**Art Unit**	
	Anatoly Vortman	2835	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *new independent claim 4 raises new issues*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-3*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *See Continuation Sheet*

A. Vortman

Anatoly Vortman
Primary Examiner
Art Unit: 2835

Continuation of 10. Other:

The Applicant's interpretation of MPEP 804.03IIA is believed to be in error, because of the following:
the aforementioned chapter of MPEP is directed do the double patenting rejection and setting forth the conditions for two inventions of DIFFERENT inventive entities to come within the provisions of 35 U.S.C. 103(c), i.e. when:
(A) the later invention is NOT anticipated by the earlier invention under 35 U.S.C. 102.

In the instant case the invention is anticipated by the earlier invention of the same inventive entity under 35 USC 102. Thus, the references of Yu ('371) and of Yu ('381) are qualify as prior art under 35 USC 102. Regarding the 35 USC 103 rejection, the commonly owned references may be disqualified as prior art under 35 USC 103 only when the following conditions are met (see MPEP 706.02(l)(3) [R-1]):

a commonly owned reference is only disqualified as prior art under 35 USC 103 (a) (via 102 (e)) when:

(A) proper evidence is filed,

(B) the reference only qualifies as prior art under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999, (e.g. not 35 U.S.C. 102(a) or (b)) and

(C) the reference was used in an obviousness rejection under 35 U.S.C. 103(a).
Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).

In the instant case the references of Yu ('371) and of Yu ('381) do NOT meet the conditions of 35 USC 103 (c) and therefore can NOT be disqualified as prior art under 35 USC 103 (a), since they are both qualify as prior art under 35 USC 102(b).

A. Vortman

ANATOLY VORTMAN
PRIMARY EXAMINER